

APR 06 2007

Application No. 10/718,614  
Reply to Office Action of September 7, 2006

Docket No.: 615388001US1

**REMARKS**

In the Office Action, claims 21, 29, and 33 are rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Mary D. Sheridan, "Manual for the Stycar Vision Tests," 1969 ("Sheridan") in view of U.S. Patent No. 5,216,458 to Andera et al. ("Andera"). Claims 22-28, 30-32, and 34-38 are rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Sheridan in view of U.S. Patent No. 5,121,981 to Waltuck et al. ("Waltuck") and further in view of Andera.

By this Amendment, Applicant amends claim 33 to recite that the portable display medium is capable of "successively and individually displaying optotypes of different sizes and shapes," so as to be consistent with the language already recited in claims 21, 25, and 29. No new matter has been added by this amendment.

Applicant respectfully requests a Personal Interview to discuss the rejections of independent claims 21, 25, 29 and 33, before further action in this case. It is believed that a personal interview will be productive to better explain the various distinctions between the pending claims and the Sheridan, Andera and Waltuck references.

1. History of Prosecution

On June 12, 2006, Applicant filed an Amendment under 37 C.F.R. § 1.111 in response to an Office Action rejecting claims 21 and 29 under 35 U.S.C. § 102(b) as being allegedly anticipated by Sheridan, and rejecting claim 25 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Sheridan in view of Waltuck. In response to this rejection, Applicant amended, for example, claim 21 to recite the steps of positioning at a predetermined distance a display medium that "is capable of individually and successively displaying optotypes of different sizes and shapes for enabling the examiner to assess a patient's visual acuity," and "controlling the display medium to individually and successively present optotypes for the patient to view from the predetermined distance." In the Remarks section, Applicant explained that Sheridan does not position a display medium

Application No. 10/718,614  
Reply to Office Action of September 7, 2006

Docket No.: 615388001US1

and control the medium to individually and successively present optotypes of different shapes and sizes. Applicant further explained that Waltuck also provided no disclosure of the claimed display medium, or of a method for successively and individually displaying optotypes.

On September 7, 2006, Applicant was mailed a final Office Action, now rejecting the claims under 35 U.S.C. § 103(a) as being obvious of Sheridan in view of Andera. In the rejection, the Office Action described (i) Sheridan as teaching "positioning a display medium comprising an optotype chart at varying distances from a subject child" (final Office Action at page 2), (ii) Andera for teaching "sequentially presenting a series of optotypes having patterns that vary in their spatial frequencies..." (final Office Action at page 3), and (iii) Waltuck for teaching "using an LCD monitor for displaying optotypes..." (final Office Action at page 3).

On November 7, 2006, Applicant filed a Request for Reconsideration Under 37 C.F.R. 1.116. In that filing, Applicant articulated why the combination of Sheridan, Andera and Waltuck fails to disclose the claimed method and apparatus for successively and individually displaying optotypes:

As the Office Action acknowledges, Sheridan is not directed to a system for individually and successively displaying optotypes of different sizes .... While Andera discloses sequentially displaying different optotypes, the references does not disclose successively displaying optotypes of different sizes, wherein the sizes of the optotypes are calibrated for display at the predetermined distance, as recited in the claim.

(Req. for Reconsideration at 2-3.) Applicant further explained that there was not motivation to combine the references.

Secondly, Applicant respectfully submits that one of ordinary skill in the art would not have been motivated to combine Andera with Sheridan. ... As can be seen, these optotypes [of Andera] are different configurations of a plurality of striped lines. Furthermore, Andera is not directed to a similar type of

Application No. 10/718,614  
Reply to Office Action of September 7, 2006

Docket No.: 615388001US1

eye examination as disclosed in Sheridan. Contrast sensitivity and spatial frequency perception are nowhere mentioned in Sheridan.

(Req. for Reconsideration at 3.)

Because no response was received from the PTO, a Notice of Appeal was filed on February 6, 2007.

On February 12, 2007, an Advisory Action was issued in response to Applicant's filing, which stated:

The request for reconsideration has been considered but does NOT place the application in condition for allowance because: ... **Applicant appears to be showing nonobviousness by attacking the references individually while the rejections are based on combinations of references.** In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). For example, contrast sensitivity or spatial frequency perception do not preclude requesting a patient to find matching optotypes.

As shown above, Applicant respectfully submits that the earlier-filed Request for Reconsideration did in fact distinguish the claimed invention from all of the references, by demonstrating that none of the references, taken singly or in combination, teaches controlling a display medium to individually and successively present optotypes for the patient to view from the predetermined distance, wherein the sizes of the optotypes are calibrated for display at the predetermined distance. Applicant also explained why one of ordinary skill in the art would not have been motivated to combine these completely unrelated references. Accordingly, Applicant respectfully requests reconsideration.

## 2. Request for Reconsideration

Claims 21, 25, 29, and 33 recite a component or step for displaying the optotypes individually and successively for the patient to view from a predetermined distance. As stated in the last paragraph of page 2 of the final Office Action, Sheridan discloses

Application No. 10/718,614  
Reply to Office Action of September 7, 2006

Docket No.: 615388001US1

positioning an "optotype chart at *varying distances* from a subject child" (emphasis added). Andera is silent regarding the distance from which the optotypes are presented to the patient. Accordingly, neither Sheridan nor Andera, taken singly or in combination, teach displaying the optotypes individually and successively for the patient to view from a predetermined distance, wherein the sizes of the optotypes are calibrated for display at the predetermined distance.

Claim 29 recites a display medium for individually and successively displaying optotypes of different sizes calibrated for display at a predetermined distance. Claims 25, 29, and 33 recite steps involving a display medium for individually and successively displaying optotypes of different sizes calibrated for display at a predetermined distance. Sheridan does not disclose a "display medium" that can display more than a single letter "successively and individually." Andera discloses displaying optotypes of different spatial frequencies, not optotypes of different sizes calibrated for display at a predetermined distance. Accordingly, neither Sheridan nor Andera, taken singly or in combination, teach a display medium for individually and successively displaying optotypes of different sizes calibrated for display at a predetermined distance or steps involving a display medium for individually and successively displaying optotypes of different sizes calibrated for display at a predetermined distance.

Even if the combination of Andera and Sheridan disclosed everything recited in claims 21, 25, 29, and 33, there is no motivation to combine Andera with Sheridan. Andera teaches a test for contrast sensitivity and spatial frequency response, while Sheridan teaches a test for visual acuity. Tests for contrast sensitivity and spatial frequency response are substantially different from tests for visual acuity. Contrast sensitivity and spatial frequency response are not measured with respect to distance from an object being viewed like visual acuity is measured. Furthermore, spatial frequency response tests require optotypes having substantially uniformly repetitious patterns, as stated in col. 2, ln. 21-23 of Andera et al., which the optotypes used for visual acuity tests

Application No. 10/718,814  
Reply to Office Action of September 7, 2006

Docket No.: 615388001US1

do not have. Due to the differences between the tests of Andera and Sheridan there is no suggestion or motivation to combine.

For the foregoing reasons, Applicant respectfully submits that independent claims 21, 29, and 33 are patentable over the combination of Sheridan and Andera.

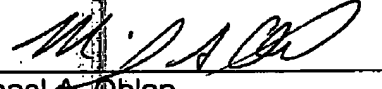
With regard to claim 25, Waltuck fails to disclose the claimed method for successively and individually displaying optotypes. Therefore, Applicant submits that the combination of Sheridan, Andera and Waltuck fails to disclose the step of successively and individually displaying optotypes of different sizes as recited in claim 25.

Additionally, Applicant submits that dependent claims 22-24, 26-28, 30-32, and 34-38 are patentable at least for being dependent from a patentable independent claim.

Applicant believes no fee is due with this response, aside from the fee for filing a Request for Continued Examination. However, if a fee is due, please charge our Deposit Account No. 50-0665, under Order No. 615388001US1 from which the undersigned is authorized to draw.

Dated: *April 6, 2007*

Respectfully submitted,

By   
Michael A. Oblon  
Registration No.: 42,956  
PERKINS COIE LLP  
607 Fourteenth Street, N.W.  
Washington, DC 20005-2011  
(202) 628-6600  
(202) 434-1690 (Fax)  
Attorney for Applicant